UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,562	03/08/2004	Christopher W. Blackburn	1842.027US1	1074

70648   7590   04/15/2011
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EXAMINER
LIPMAN, JACOB

ART UNIT	PAPER NUMBER
2434	

NOTIFICATION DATE	DELIVERY MODE
04/15/2011	ELECTRONIC

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PTOL-90A (Rev. 04/07)

1   RECORD OF ORAL HEARING

2   UNITED STATES PATENT AND TRADEMARK OFFICE

3   _____

4   BEFORE THE BOARD OF PATENT APPEALS

                 AND INTERFERENCES

5

6   _____

7   *Ex Parte* CHRISTOPHER W. BLACKBURN, RORY L. BLOCK,

        THOMAS A. GENTLES, VIKRAM SWAMY

8   and TERRY D. WARKENTIN

9   _____

10   Appeal 2010-002773

            Application 10/796,562

11   Technology Center 2400

12   _____

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       Oral Hearing Held: October 13, 2010

14   _____

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Before JOSEPH L. DIXON, JEAN R. HOMERE, and STEPHEN C. SIU,

16 *Administrative Patent Judges.*

17

18 APPEARANCES:

19

20 ON BEHALF OF THE APPELLANT:

21

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1   The above-entitled matter came on for hearing on Wednesday,

2   October 13, 2010, commencing at 10:00 a.m., at the U.S. Patent and

3   Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Jack

4   Becker, a Notary Public.

5   THE USHER: Calendar No. 20, Appeal No. 2010-002773. Mr. Lacy.

6   JUDGE DIXON: Hello, Mr. Lacy.

7   MR. LACY: Good morning.

8   JUDGE DIXON: You have 20 minutes. You may begin when you're

9   ready.

10   COURT REPORTER: Excuse me. Can I have him go the podium?

11 That's for --

12   JUDGE DIXON: Sure. He has a microphone there, but --

13   MR. LACY: Oh, sure, yeah. Absolutely.

14   COURT REPORTER: Also, do you have a business card?

15   MR. LACY: I can get you one. Yeah. Do you want it now?

16   COURT REPORTER: Yes, please.

17   MR. LACY: Good morning, Your Honors. This case is directed to

18 provision of services in a gaming network, a wagering game network.

19 Various services can be provided, such as a progressive service that keeps

20 track of jackpots that are shared by numerous machines, accounting services

21 that account for money coming in and out of the machines through cashless

22 gaming systems. In one way that these services are provisioned is that

23 there's a three-way handshaking that's described in Figure 3 of our

24 specification, where a service provider desires to publish its information to a

25 discovery agent. The discovery agent then makes information about locating

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1   that service to various clients and client services, and then services

2   requesting those services can contact the discovery agent to find the location

3   of that service.

4   One aspect that we're claiming of this handshake is that the discovery

5   agent authenticates and authorizes the service before it is published and

6   made available on the gaming service network. You want to, obviously, be

7   cognizant of the fact that you don't want rogue services on the network. For

8   example, a rogue accounting service could take, in an unauthorized manner,

9   money from the machines that were intended for another purpose.

10   Now, in this case, the Final Office Action cites Gatto, the 247 patent,

11   as disclosing this aspect of authorization and authentication of a service by a

12   discovery agent, and in doing so it interprets the authentication engine in

13   Gatto as the equivalent of our discovery agent. It is our position that this

14   interpretation is incorrect. The authentication engine in Gatto is intended to

15   authenticate operations between entities, so one thing that's inherent in that

16   is that the entity is already in operation. It's already on the network. It's

17   already running. The other aspect that we see in the Gatto reference and a

18   number of the related cases is that there's no publishing by any entity of

19   service information, there's no publishing of service information by an entity

20   in Gatto. So there really isn't the equivalent of a discovery agent disclosed

21   in Gatto.

22   JUDGE DIXON: Counsel, have you defined what publishing is?

23   MR. LACY: Publishing is making service information available.

24   Page 11 of the specification goes into that to a certain extent. It's also a term

25   of art in terms of --

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1   JUDGE DIXON: Where on page 11?

2   MR. LACY: On page 11 at the bottom, starting at line 21. Actually,

3   the actual text is that service requestors may find services and obtain binding

4   information during the development for static binding. That binding and

5   obtaining that information is the publishing aspect of the discovery agent.

6   There's also a publish interaction.

7   JUDGE DIXON: But it doesn't necessarily define.

8   MR. LACY: Yeah. The publish interaction is also --

9   JUDGE DIXON: So --

10   MR. LACY: I'm sorry. Page 14 also provides some information

11   about the publish interaction, starting at line 10. Publish interaction 330

12   provides a mechanism for a service to be made accessible to other entities in

13   the gaming network.

14   JUDGE DIXON: 14, line 10?

15   MR. LACY: Yeah. Starting at 14, line 10, Your Honor. And,

16   actually, different forms of publishing are described starting at line 10 on

17   page 14, going through page 15, line 23. Most of that discussion --

18   JUDGE DIXON: But that doesn't define it either. That just gives us

19   an example that we publish, we put something out somewhere. So the

20   Examiner cited us to column 10, basically, of Gatto.

21   MR. LACY: That's correct.

22   JUDGE DIXON: Which says they use a certificate authority, which

23   seems to be a third party.

24   MR. LACY: It can be, Your Honor, yeah.

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1   JUDGE DIXON: And, it says that the computer network is connected

2 thereto to certify the authenticity of the identification presented to authorize

3 a given operation.

4   MR. LACY: Correct.

5   JUDGE DIXON: Well, if it authorizes an operation, you have to do

6 something, some communication, some action to authorize. You can't

7 authorize something without some action, which to me says I have to publish

8 something, I have to say something, I have to do something. I can't

9 authorize my child to do something, my employee to do something. I have

10 to publish. So, I mean, granted, the Examiner didn't cite you too much,

11 but --

12   MR. LACY: Right.

13   JUDGE DIXON: Right there, I mean, that seems to me that you don't

14 have much in the way of a definition of publish. It says you put something

15 out somewhere to let them know, but Gatto says I'm going to tell somebody

16 that it's okay to do something, which seems to me, in line with what your

17 broad examples seem to say in your specification, at least what you've

18 identified here.

19   MR. LACY: Sure.

20   JUDGE DIXON: I mean, there may be something else there that --

21 but in your Brief -- your Brief is brief.

22   MR. LACY: Yes. The publication aspect -- I think publication by its

23 very name implies -- publishing and publication implies a public nature to it.

24 There's no indication in Gatto that the information that's authorized is public

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1   beyond the two entities in the transaction, the authentication engine and

2   whatever is being authorized. I think to --

3   JUDGE DIXON: That would go to -- you know, what is a publication

4   under, you know, when we get into our interpretation under 102 and under

5   the law and stuff like that? What's a publication?

6   MR. LACY: Sure.

7   JUDGE DIXON: But do we have to get there under a 102? I mean,

8   just -- it's a 102. It says what's published. You know, we could argue over

9   definitions but, you know, they said I told you this. I published it to you.

10 What does the claim require? It just says the claim requires publishing by

11 the discovery agent service information to a service repository to make the

12 gaming service available on the gaming network. It doesn't say how many

13 people are on the network. You haven't defined how many people are on a

14 network. It could be two people.

15   MR. LACY: Sure.

16   JUDGE DIXON: It could be more, but we're in a method here. We

17 haven't defined the boundaries of our network because we're not in an

18 architecture of the network. We're not an apparatus claim. We're a method

19 claim.

20   MR. LACY: Correct. The one aspect that you mentioned about the

21 claim is publication of the service information to a service repository. The

22 indicated portion of Gatto cited by the Examiner doesn't indicate that any

23 information is published into a repository. It's merely a transaction.

24   JUDGE DIXON: What's a service repository? Do you have a

25 definition of that?

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1   MR. LACY: That would be -- the UDDI is one specific example.

2 UDDI starting at --

3   JUDGE DIXON: That's one example, but --

4   MR. LACY: I'm sorry.

5   JUDGE DIXON: That's one example, but that's not in the claim

6 but --

7   MR. LACY: Well, it's an example.

8   JUDGE DIXON: So, have you defined it as -- I mean, it's all claim

9 interpretation.

10   MR. LACY: Sure.

11   JUDGE DIXON: I mean, is that -- does that make what the Examiner

12 cited unreasonable under 102?

13   MR. LACY: Well, I think it does, because he doesn't cite publishing

14 service information into a repository to make it available on the network,

15 he's merely citing that transactions between two entities can be authorized.

16 It doesn't go into this publication aspect. I understand what you're saying

17 about the fact that there is a communication between two entities, but it

18 doesn't take that further step of making that service information publicly

19 available on a network so that other entities can contact the service provider.

20   JUDGE HOMERE: Counselor --

21   MR. LACY: Yes.

22   JUDGE HOMERE: -- the claim limitation in question here seems to

23 be directed to -- upon authorizing or authenticating that particular device,

24 you make the game system available on the network.

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1   MR. LACY: We authenticate services, which can be distinguishable

2 from devices, but, yes, we do do that.

3   JUDGE HOMERE: Okay. And you make it available on the

4 network, right?

5   MR. LACY: We make it available on the network such that other

6 services and clients can contact the service provider.

7   JUDGE HOMERE: Okay, but are you actually filling that in? That's

8 not in the claim. I'm looking at the claim here. It says that the gaming

9 services authenticate and authorize publishing by the discovery agent service

10 information to a service repository to make the gaming service available on

11 the game network.

12   MR. LACY: Correct.

13   JUDGE HOMERE: Now, it seems to me that portion of the prior art

14 before us has that certificate authority that authenticates a particular gaming,

15 and it says that this gaming system or this system that we're dealing with

16 here can be on a computer network.

17   MR. LACY: Yes.

18   JUDGE HOMERE: So, therefore, it seems that upon authenticating

19 that gaming system, if the authentication is successful, therefore, that

20 gaming system would be available -- it would be made available to the

21 network.

22   MR. LACY: I think the authentication that's described in Gatto, as

23 we said before, is authenticating operations on the network and

24 authenticating identities of users for various services or aspects of the

25 gaming. It doesn't publish it to make it available on the network.

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1   JUDGE HOMERE: But what would it do? What do you think that it

2   does after authenticating the user -- authenticating that, well, this person is

3   or this device is allowed to be on the network? What do you think it does?

4   Because it says in parenthesis -- which may be located by the server on a

5   network, a computer network connected thereto. So, well, then it would be

6   over the network. So, essentially, what we have, we have a network that has

7   at least the gaming system and authentication authority.

8   MR. LACY: Correct.

9   JUDGE HOMERE: And upon authenticating that gaming system, it

10   does something with it.

11   MR. LACY: I think we're going at a lower level of granularity, so to

12   speak, in that we're authenticating components on the network, the services

13   on the network. Maybe I'm not understanding your question correctly, but

14   we're not authenticating --

15   JUDGE HOMERE: I'm trying to understand this passage here in the

16   prior art.

17   MR. LACY: Sure, yeah.

18   JUDGE HOMERE: Okay. It says that you have a certificate

19   authority --

20   MR. LACY: Correct.

21   JUDGE HOMERE: -- and then that served the purpose of

22   authenticating -- that's on a network --

23   MR. LACY: It provides authentication services on the network.

24   JUDGE HOMERE: On a network, okay. They serve the purpose of

25   authenticating a gaming device. So my question to you is, upon

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1   authenticating the gaming device, what does it do based on this portion here?

2   Because we are a network, you've got to have access to what you've done .

3   MR. LACY: The passage doesn't specifically say that it authenticates

4   devices. It authenticates identification, and in a previous portion of Gatto it

5   refers to users logging in so it can authenticate their identity and it ensures

6   data integrity, meaning that, you know, that the data is good and it

7   authenticates operations. It doesn't specifically go into authenticating

8   services or devices. In respect to that, actually, on column 12, which was

9   cited in the Examiner's Reply Brief -- or Examiner's Answer, it says that the

10 authentication engine can maintain a registry of devices and dispatch alerts,

11 but it doesn't say anything about publication after doing its authentication or

12 authorization.

13   JUDGE HOMERE: Well, if you make it available on a network,

14 would that consist --

15   MR. LACY: I think if it somehow made it available -- I just don't see

16 that in Gatto. I mean, I don't see what the -- I don't see that the -- the

17 authority performs a function and the certificate authority performs a

18 function in that it authenticates and authorizes, but that's the extent of what

19 it does. It doesn't do anything regarding publication after that authentication

20 or authorization.

21   JUDGE HOMERE: Let's agree that this reference -- in this reference

22 a user tries to -- try to authenticate himself before he can access a particular

23 system, right?

24   MR. LACY: Pardon me.

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1   JUDGE HOMERE: They authenticate an authority on the prior art

2   here, on Gatto. It serves the purpose of authenticating the ID of a user,

3   right?

4   MR. LACY: It can do that, yes.

5   JUDGE HOMERE: Okay. Now, upon authenticating the user, the

6   user has access to the device or to the gaming system.

7   MR. LACY: The user would have access to the gaming system, but

8   the user would only have access to aspects of the system themselves that

9   have been authenticated and authorized.

10   JUDGE HOMERE: Okay. Now, since we are on a network, would

11   that access itself constitute publication, because they are on the network?

12   MR. LACY: They would have access to whatever is on the network.

13   JUDGE HOMERE: Exactly.

14   MR. LACY: I misspoke. The user would have access to what's on

15   the network. I'm not saying that Gatto authenticates and authorizes services

16   on the network, I'm just saying users have access to the network.

17   JUDGE HOMERE: To the network?

18   MR. LACY: To what -- yeah -- well --

19   JUDGE HOMERE: To the gaming system or to those aspects for

20   which the user was authenticated.

21   MR. LACY: Yeah. Gatto speaks to a payment verification unit and

22   identifying a user of the payment verification unit and authenticating that,

23   you know, through a card or a password situation.

24   JUDGE HOMERE: All right.

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1   JUDGE DIXON: The Examiner further -- in his Answer further

2   identifies column 12.

3   MR. LACY: Correct.

4   JUDGE DIXON: And you didn't file a Reply Brief?

5   MR. LACY: I felt at the time that the original brief addressed that

6   issue in that the section that was cited by the Examiner states that the

7   authentication engine maintains a registry of devices and uses that to

8   dispatch alerts. It doesn't use it to publish anything. The Brief, as filed,

9   stated that Gatto doesn't disclose a discovery agent that publishes upon

10 authentication an authorization of the service. In hindsight --

11   JUDGE DIXON: So, you just repeated the claim language and said

12 we reviewed Gatto and we didn't see the discovery agent.

13   MR. LACY: Pardon me?

14   JUDGE DIXON: You basically repeated the claim language and said

15 we have reviewed Gatto and we don't see that it teaches the claim language,

16 was the quote?

17   MR. LACY: Correct.

18   JUDGE DIXON: But then you didn't respond to what the Examiner's

19 position was. Basically, the Examiner had further, you know, points in

20 Gatto, and you had a prior citation to the claim language and said we've

21 reviewed the entire reference and we don't think anything in the reference

22 teaches this?

23   MR. LACY: Right. You're right. We didn't file a --

24   JUDGE DIXON: It leaves you wondering, you know --

25   MR. LACY: I can certainly address that question. The --

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1   JUDGE DIXON: I mean, it has a registry, which is what you're

2   pointing to is the UDDI portal registry. And then you're saying, well, this is

3   a registry but it's not our registry which publishes, which -- well, it's a

4   registry, which is what the Examiner is saying, well, it has a registry which

5   publishes, but now you're saying well, that's not our registry.

6   MR. LACY: I'm not saying the UDDI is in our registry. I'm saying

7   that the authentication engine and maintaining a registry of authorized

8   devices -- that passage on column 12 of Gatto does not do any kind of

9   publication. It just says it dispatches alerts to prevent illegal devices from

10 operating --

11   JUDGE DIXON: But it is a list of authorized devices that --

12   MR. LACY: Yes it is.

13   JUDGE DIXON: But isn't that sort of in the realm of publishing? I

14 mean, it's a list, it's out there, it's information that's available. The question

15 then goes back to what's published? It's a registry of information which is

16 available. It goes to authorized devices. What are we trying to do in Gatto

17 and in the claimed invention is prevent unauthorized usage of the system.

18 It's in the realm of it.

19   MR. LACY: I think --

20   JUDGE DIXON: The question then comes up, well it certainly

21 sounds like it's relevant material, and you didn't respond to it. We just have

22 the preliminary citation from you that we reviewed it and we didn't see

23 anything that, you know, met our exact claim language. But, then the

24 Examiner comes back and says, well, here's something else that's quite

25 relevant in the responsive arguments, and then we got no Reply Brief. So,

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1 we're left to, arguably, accept that from the Examiner. That's because we

2 have silence on your part.

3   MR. LACY: I'd like to dispel the silence at the hearing here.

4   JUDGE DIXON: But, we're supposed to decide the appeal on the

5 written record.

6   MR. LACY: Sure. Well, I think our statement in the Brief is still

7 accurate in that the passage quoted by the Examiner in the Examiner's

8 Answer still doesn't address publication. Part of your question, I think,

9 mentioned the fact that the registry is there and available. The registry -- I

10 guess available to whom is the question. It may be --

11   JUDGE DIXON: Which goes back to network and who's on the

12 network, what's the network, but we're a method claim --

13   MR. LACY: Well, there's also a system claim that -- claim 15 --

14   JUDGE DIXON: We're all grouped together.

15   MR. LACY: True. Yup. Okay. Understood, Your Honor.

16   JUDGE DIXON: Stand or fall.

17   MR. LACY: Yup.

18   JUDGE DIXON: You've got a lot of problems. It's a brief Brief, as I

19 said before. It's one argument. They all stand or fall together.

20   MR. LACY: Yup. I'll just go back to the statement, Your Honor,

21 that, you know, it doesn't disclose making that registry available to anyone.

22 It could be used for its own internal purposes to send an alert to a technician

23 that there's something going on on the network.

24   JUDGE DIXON: Okay. Any further questions? Okay.

25   You have any closing?

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1   MR. LACY: Just to sum up, again, we don't believe that Gatto

2   discloses in the way that we claimed, in the arrangement that we claimed,

3   the discovery agent that authorizes and authenticates services before

4   publication. One final thing, too, I did mean to bring up is that Gatto does

5   disclose that developers can publish information at column 15, which --

6   that's the sole reference to publishing in the Gatto reference is at column 15,

7   line 55. I'd be happy to answer any other questions that you have.

8   JUDGE DIXON: None.

9   JUDGE HOMERE: No.

10   MR. LACY: Okay. Thank you, Your Honors. I appreciate your

11   time.

12   (Whereupon, the proceedings, at 10:23 a.m., were concluded.)

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